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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/829,640

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James E. Swon

04-02 US

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23693

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01/24/2008

Varian Inc.

Legal Department

3120 Hansen Way D-102

Palo Alto, CA 94304

EXAMINER

HANDY, DWAYNE K

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

01/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/829,640	<b>Applicant(s)</b> SWON ET AL.	
	<b>Examiner</b> Dwayne K. Handy	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 44-54 and 64-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-54 and 64-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 44-54 and 64-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah (3,801,280). This rejection was applied to claims 44-63 in Paragraph 2 of the Office Action mailed 8/7/07. It now applies to claims 44-54 and new claims 64-73. Please see Response to Arguments below.

3. Claims 44-46, 49-54, 64-66 and 68-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah (3,801,280). This rejection was applied to claims 44-63 in Paragraph 2 of the Office Action mailed 8/7/07. It now applies to old claims 44-46 and 49-54 as well as new claims 64-66 and 68-73. Please see Response to Arguments below.

***Response to Arguments***

4. Applicant's arguments filed 11/06/07 have been fully considered but they are not persuasive. Applicant has amended claims 44-54 to change the term "sample carrier" to "implantable medical device". Applicant has also added new claims 64- 73 which are similar to claims 44-54, but contain the term "the dosage form" in place of the "sample carrier". Applicant has then argued (page 6, lines 5-22 of Arguments submitted 11/06/07) that neither of the references teach these features – the implantable medical device or dosage form – that can be supported within a container and driven into motion within the container without any contact with the driving force utilized to effect the actuation. The Examiner respectfully disagrees.

As was the case with the previous term used in the claim - "sample carrier" – Applicant is still using terms that are broadly defined by their function – "implantable medical device" and "dosage form". In addition, Applicant has defined these terms in paragraphs [0030]-[0032] of the Specification as "any composition or structure that can provide a sample in dissolution testing..... such as a pharmaceutical drug, chemical, biochemical, or biologically active material intended for delivery by ingestion, injection, insertion, transdermal injection, transdermal delivery, surgical implantation, or the like in a human or animal.... Non limiting example of dosage forms may include tablets, capsules, caplets, gel caps, pellets, microspheres....". Therefore, a device that contained a means for supporting any of the elements listed by Applicant and a drivable component attached would meet the broad claim limitations.

5. The Examiner argued in the previous Office Action that any element that is capable of supporting the sample carrier would meet the limitation of a supporting means. This is still true in the case of "implantable medical devices" and "dosage forms" of the amended/new claims. In the case of Zuellig, the Examiner considers the agitation element (#35) to be a "means for supporting" the implantable medical device or dosage form that has a "drivable component" attached to it. The agitation element is comprised of a drivable inner portion and an outer portion that can support an implantable medical device or dosage form as disclosed by Applicant. When the inner magnetic portion is driven by the externally positioned magnet (500), the outer portion moves as well (See paragraph 5A of the action mailed 8/7/07). This drives the driving component and the implantable medical device or dosage form. In the case of Shah, the Examiner considers the filter element (#8) to be a "means for supporting" the implantable medical device or dosage form that has a "drivable component" attached. It may be considered a "means for supporting the implantable medical device or dosage form" because the filter may contain the medical device or dosage form. When the magnetic portion (16) in the base (9) is driven by the externally positioned magnet, the filter and its contents move as well. This actuates the driving component and the implantable medical device or dosage form (See paragraph 5A of the action mailed 8/7/07).

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH  
January 21, 2008

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700